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OFFICE OF PETITIONS

In re Application of
Cheol Kim
Application 09/254,058
Filed: June 14, 1999
Attorney Docket No. 2016-11

ON PETITION

This is a decision on the third renewed petition under 37 CFR 1.137(b), filed December 12, 2008, to revive the above-identified application.

The petition is **DENIED**.

BACKGROUND

This application became abandoned for failure to submit a proper response to the non-final Office action mailed October 3, 2003 which set a shortened statutory period for reply of three (3) months. A three month extension of time under 37 CFR 1.136(a) was filed on April 5, 2004. Accordingly, by operation of law, the above-identified application became abandoned on April 6, 2004 (April 3, 2004 was a Saturday). A Notice of Abandonment was mailed July 2, 2004.

A first petition under 37 CFR 1.137(b) was filed November 20, 2006, and was dismissed in the decision of August 16, 2007 for lack of an acceptable statement of unintentional delay.

A renewed petition under 37 CFR 1.137(b) was filed October 9, 2007, and was dismissed in the decision of January 31, 2008 for lack of an acceptable statement of unintentional delay.

A second renewed petition under 37 CFR 1.137(b) was filed April 30, 2008, and was dismissed in the decision of June 12, 2008 for lack of an acceptable statement of unintentional delay.

The instant third renewed petition under 37 CFR 1.137(b) was filed December 12, 2008.

The present renewed petition is accompanied by a Written Statement signed by Won-Il Lee, who is petitioner's Korean patent attorney from the firm of Youme Patent & Law Firm (Youme), and a Written Statement signed by the applicant, Kyu Jin Park.

In his statement, Lee states in paragraph 4.

I continued to ask the applicant to resolve the non-paid amount of money and to ask the applicant to continue or not the present case application, and the applicant confirmed to continue the present case application but he failed to pay the pending balance because of the applicant's financial crisis. So, I had to instruct Mr. Chuck Burpee of WNJ to give up the proceedings of the present case application.

WNJ, Warner Norcross & Judd LLP, was the U.S. associate for Youme.

In his statement, Park, the applicant, states in part

At this time, Youme, which is my Korean local agent, asked me to pay about US\$30,000 including its service charge and a fee of the US agent, and I could not afford the money. So, Youme informed me of no further proceedings which could cause costs if I could not pay the money, but I could not find any way to pay the money. So, I gave up the proceedings of the application but the give-up of the application was not my intention.

STATUTES AND REGULATIONS

35 U.S.C. § (2)(B)(2) provides, in part, that:

The Office-- may, establish regulations, not inconsistent with law, which

(A) shall govern for the conduct of proceedings in Office.

Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, provides for the revival of an "unintentionally" abandoned application without a showing that the delay in prosecution or in late payment of an issue fee was "unavoidable." Specifically, 35 U.S.C. § 41(a)(7) provides that the Commissioner shall charge:

On filing each petition for the revival of an unintentionally abandoned application for a patent or for the unintentionally delayed payment of the fee for issuing each patent, \$1500, unless the petition is filed under section 133 or 151 of this title, in which case the fee shall be \$500.

37 CFR 1.137(b) provides:

Unintentional. Where the delay in reply was unintentional, a petition may be filed to revive an abandoned application or a lapsed patent pursuant to this paragraph. A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (c) of this section.

OPINION

Petitioner asserts in the instant renewed petition that he never had any intention of abandoning his application even though he did not have the funds to support further prosecution.

35 U.S.C. § 41(a)(7) applies to the situation of the above-identified application (i.e., to the revival of an abandoned application), however, it precludes the Director from reviving the above-identified application. The patent statute at 35 U.S.C. § 41(a)(7) authorizes the Director to revive an "unintentionally abandoned application." The legislative history of Public Law 97-247 reveals that the purpose of 35 U.S.C. § 41(a)(7) is to permit the Office to have more discretion than in 35 U.S.C. §§ 133 or 151 to revive abandoned applications in appropriate circumstances, but places a limit on this discretion, stating that "[u]nder this section a petition accompanied by either a fee of \$500 or a fee of \$50 **would not be granted where the abandonment** or the failure to pay the fee for issuing the patent **was intentional** as opposed to being unintentional or unavoidable." [emphasis added]. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. The revival of an intentionally abandoned application is antithetical to the meaning and intent of the statute and regulation.

35 U.S.C. § 41(a)(7) authorizes the Commissioner to accept a petition "for the revival of an unintentionally abandoned application for a patent." As amended December 1, 1997, 37 CFR 1.137(b)(3) provides that a petition under 37 CFR 1.137(b) must be accompanied by a statement that the delay was unintentional, but provides that "[t]he Commissioner may require additional information where there is a question whether the delay was unintentional." Where there is a question whether the delay was unintentional, the petitioner must meet the burden of establishing that the delay was unintentional within the meaning of 35 U.S.C. § 41(a)(7) and 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989). Here, the showing is that applicant intentionally delayed in the filing of a response to the non-final Office action mailed October 3, 2003. The record indicates that without payment of the requested legal fees petitioner's attorney would not be able to file a response to the Office action. Petitioner apparently understood the consequences of a lack of further prosecution based on his statement that he "gave up proceeding of the application."

Accordingly, the issue in the instant application is whether or not petitioner, by a deliberate course of action, intentionally abandoned the application. Such deliberate action precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137. See *Maldague*, 10 USPQ2d at 1478. Petitioners' statement, in the instant renewed petition, that "I gave up the proceeding of the application" shows a deliberate course of action which resulted in the abandonment of the application. Lee's instructions to WNJ to "give up the proceedings of the present case application" was a clear indication to not respond to the outstanding Office action and both Lee, as petitioner's Korean patent attorney and WNJ, the U.S. associate prosecuting the application, understood this would result in abandonment of the application. Such action precludes a finding of unavoidable or unintentional delay pursuant to 37 CFR 1.137.

A change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application. See MPEP 711.03(c)(1). At the time a response to the Office action was due, petitioner allegedly had no funds to pay the fees required by his local patent attorney, Lee, to further prosecution of the application. At some later point, after the application had gone abandoned, petitioner's financial situation had apparently improved to the point he was able to pay the required fees to continue prosecution of his patent application. This change in financial status certainly falls within the realm of a "change in circumstances."

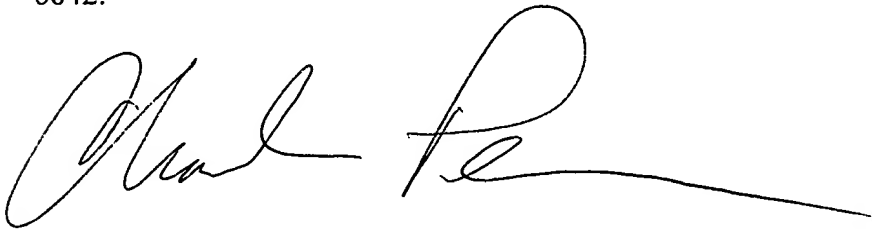
Where, as here, the applicant deliberately withholds the filing of a proper response, the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See *In re Application of G*, *supra*. An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *Maldague*, *supra*.

DECISION

For the reasons given above, petitioner has not demonstrated to the satisfaction of the director that the entire delay herein was unintentional within the meaning of 35 USC 41(a)(7) and 37 CFR 1.137(b). Accordingly, this abandoned application will not be revived.

This decision is a final agency action within the meaning of 5 USC 704 for the purposes of seeking judicial review. See MPEP 1002.02.

Telephone inquiries concerning this decision should be directed to Carl Friedman at (571) 272-6842.

A handwritten signature in black ink, appearing to read 'Charles Pearson', with a long horizontal flourish extending to the right.

Charles Pearson
Director, Office of Petitions